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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,490	12/28/2000	David A. Rieger	12688US01	9503
23446	7590	04/10/2006	EXAMINER	
MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			MILEF, ELDA G	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 04/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/752,490	<b>Applicant(s)</b> RIEGER ET AL.	
	<b>Examiner</b> Elda Milef	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. In view of the Appeal Brief filed on 1/17/2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Specification as originally filed discloses the following:

- \* "All entries in the Fig. 4 pop-up represent information regarding a single inquiry, for which no two blocks of securities may (typically) have the same issuer. Separate inquiries are entered in separate "Inquiry Entry" pop-up windows." P. 7 lines 22-27,
- \* "quantity, such as inquiry block sizes description (e.g. 2X100/50 indicating one inquiry line for two blocks

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of 100 and a second inquiry line for one block of 50) in column 114". P. 7 lines 25-26.

\* "the issuer will be check against any previous scenarios or executions that have involved other blocks from the inquiry. If a similar or matching issuer is found, the user will be warned and given the option to either use or not use the block in the scenario." P. 12 lines 9-13.

The Specification as originally filed does not disclose the combination of a plurality of inquiry blocks for a single inquiry, whereas no two blocks of securities for said single inquiry are to have the same associated issuer.

Claims 9-10 are rejected because of their dependency to the rejected claim 8.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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**Re claim 1:** The limitations set forth in claim 1, "entering into a computer potential purchase information describing available securities" and "entering into the computer a plurality of algorithms for matching the inquiry information with the purchase information" is unclear. The Examiner is uncertain as to who is entering this information or where this information is coming from.

**Claims 2-28** are rejected because of their dependency to the rejected claim 1.

**Re claim 8:** The Examiner is uncertain of the meaning of the term "inquiry blocks". Is this referring to the inquiry block sizes or quantity?

**Claims 9, 10** are rejected because of their dependency to the rejected claim 8.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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4. Claims 1-8, 11, 14-15, 17-36, 39, 42-43, 45-56  
rejected under 35 U.S.C. 103(a) as being unpatentable over Broka  
(US Patent No. 5,809,483).

**Re claim 1:**

The Examiner is interpreting "entering into the computer potential purchase information describing available securities" to mean -- a host processor accesses databases and transmits requested information to the user-- and "entering into the computer a plurality of algorithms for matching the inquiry information with the purchase information" to mean --a method that supplies the client with filtered data based on client preferences--;

Broka disclose:

entering by a user into the computer inquiry information describing securities desired for purchase ("Users input data requests and trade information to the user stations...")-see Abstract and col. 26 lines 36-53;

entering into the computer potential purchase information describing available securities ("The host processor processes information about the trades and requests for information using databases which contain various types of information using databases which contain various types of information about the debt securities and users. The host processor transmits

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processed trade information and request information to the user stations which present the information to the users.")=see Abstract and col. 27 lines 8-16;

entering into the computer a plurality of algorithms for matching the inquiry information with the purchase information; selecting by the user one of the algorithms

("When the user selects Filters button 3460, FIPS displays an Issue Filter window 3500 as shown in FIG. 35 from which the user selects one or more filter criteria. The criteria are represented by the various functions. Entering a symbol in field 3501 allows a user to begin listing issues by symbol. The user may enter a partial or full symbol ID...A user may also select Coupon Rate button 3530 and enter a coupon rate in the associated text box 3531. FIPS will then search the issue table 731 (FIG.7) for issues at the given rate... A user may also select Maturity Year button...")-see col. 19 lines 9-47;

matching by means of a user selected one algorithm the inquiry information with the purchase information ("Directory services allow users to search databases using different criteria...A user can browse the bond database... to find issues of a given coupon rate and maturity year...FIPS utilities allowing users to customize certain interfaces and data presentation formats.")-see col. 5 lines 58-65. Although Broka does not



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explicitly disclose "matching" it is obvious that in order for the system to display the user requested securities information based on user filter criteria, the system must "match" the criteria to the product features.

reporting to the user the results of the matching by means of the computer ("The host processor transmits processed trade information and requested information to the user stations which present the information to the users")-see Abstract, col. 1 line 6- col. 2 line 10.

**Re claim 2:** Broka disclose:

wherein said inquiry information comprises a desired security par dollar amount for each of at least some of said securities desired for purchase, wherein said purchase information comprises an available security par dollar amount for each of at least some of said available securities and wherein said selected one algorithm attempts to match said desired security par dollar amounts with said available security par dollar amounts. ("The user enters the face value amount of the transaction in thousands of dollars in quantity field 1220...")-see Col. 11 lines 46-48 Fig. 15("QTY(\$000) PAR or Face Value"), col. 22 lines 38-40, Fig. 50.

**Re claim 3:** Broka disclose:

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matching said desired security par dollar amounts in turn with said available security par dollar amounts-see Fig. 14 ("QTY(\$000)").

**Re claim 4:** Broka disclose:

wherein said inquiry information comprises a desired range of maturity times of at least some of said securities desired for purchase, wherein said purchase information comprises a maturity time for at least some of said available securities and wherein said selected one algorithm attempts to match said range of maturity times of said securities desired for purchase with said maturity time for said available securities. -see col. 19 lines 25-28.

**Re claim 5:** Broka disclose:

wherein said selected one algorithm attempts to match inquiry information having a smaller range of maturity times before attempting to match inquiry information having a larger range of maturity times-see col. 19 lines 25-28 Fig. 35 (3541).

**Re claim 6:** Broka disclose:

wherein said inquiry information is arranged in order and wherein said selected one algorithm attempts to match said purchase information with said inquiry information according to said order -see col. 19 lines 9-34.

**Re claim 7:** Broka disclose:

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wherein said order is the order in which said inquiry information was entered into said computer-see col. 16 lines 30-34.

**Re claim 8:** The Examiner is interpreting "inquiry blocks " to mean the quantity of the security. Broka disclose said entering inquiry information comprises entering a plurality of inquiry blocks for a single inquiry. -see col. 13 line 45- col. 14 line 4. Broka does not disclose whereas no two blocks of securities for said single inquiry are to have the same associated issuer. It is old and well known in the art of securities trading that investing in bonds with different issuers is commonly done to avoid wash sales and thus avoid negative tax implications. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Broka to include when requesting data relating to a security or trade, that the request is entered for different issuers as is commonly known in the art of investing in order to avoid negative tax consequences from wash sales.

**Re claim 11:** Broka disclose:

wherein said entering purchase information comprises entering a plurality of entries about said available securities, at least some of said entries comprising a name of an issuer of

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the available security associated with the entry ("Data included in the general data area 5010 includes Par Value field 5011, which is the value of the bond, CUSIP field 5012, which is the CUSIP designation for the issue, name field 5014, which is the issuers name...")-see col. 22 lines 39-44.

**Re claim 14:** Broka disclose:

reporting comprises displaying results on said computer display-see col. 1 line 61-col 2 line 10.

**Re claim 15:** Broka disclose:

finalizing a trade of at least one of said available securities trade input means for inputting data to the trade databases indicating that a trade was executed. -see col. 26 lines 11-12.

**Re claim 17:** Broka disclose:

finalizing comprises checking for similar or matching issuers for previous security purchases for said inquiry information - see col. 14 lines 38-41.

**Re claim 18:** Broka disclose:

reporting further comprises listing said available securities for which a trade was finalized.

("The Status column may contain the following codes: A for an Active quote; Cl for a Closed market; H for a Halted Issue; Pr for a Preopen market; and W for a Withdrawn. A withdrawn quote

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requires an additional letter to represent the reason for the withdraw"-see col. 14 lines 66- col. 15 line 3 and Fig.38 (Status).

**Re claim 19:** Broka disclose:

reporting comprises listing said inquiry information not subject to said finalizing-see Fig. 38(Status), and col. 14 line 66- col. 15 line 3.

**Re claim 20:** Broka disclose:

said available securities are issued by an issuer and wherein said reporting further comprises listing approved issuers. -see col. 24 lines 20-23 and FIG. 54.

**Re claim 21:** Broka disclose:

entering potential purchase parameters or using parameters of an selected inquiry in said inquiry information; searching a database for security information corresponding to said

parameters; and reporting the results of said searching-see Abstract, col. 1 line 61- col. 2 line 10, col. 5 lines 58-64.

**Re claim 22:** Broka disclose:

wherein said database is located remotely from said computer and wherein said searching comprises transmitting data via the Internet("The software platforms of hosts 210 and 220 provide support for networking, remote operations, event

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monitoring, remote duplication, and distributed processing...)"-  
see col. 8 lines 15-18, col. 7-8 and Fig. 2.

**Re claim 23:** Broka disclose:

wherein said entering potential purchase information  
comprises:  
selecting one of said available securities;  
and reporting information about said selected security from a  
database ("allows a user to begin listing issues by symbol...")-  
see col. 19 lines 12-14.

**Re claim 24:** Broka disclose:

wherein said database is located remotely from said  
computer and wherein said reporting comprises transmitting data  
via the Internet-see cols. 7-8 and Fig.2.

**Re claim 25:** Broka disclose:

wherein said entering inquiry information comprises:  
receiving said inquiry information from a database; and  
reporting said received inquiry information -see Abstract, col.  
col. 1 line 61- col. 2 line 10, col. 5 lines 58-64.

**Re claim 26:** Broka disclose:

wherein said database is located remotely from said computer and  
wherein said reporting comprises transmitting data via the  
Internet -see cols. 7-8 and Fig.2.

**Re claim 27:** Broka disclose:

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wherein said entering potential purchase information comprises:

receiving said potential purchase information from a data - base;

and reporting said received potential purchase information -see Abstract, col. 1 line 61- col. 2 line 10, col. 5 lines 58-64.

**Re claim 28:** Broka disclose:

wherein said database is located remotely from said computer and wherein said reporting comprises transmitting data via the Internet-see cols. 7-8 and Fig. 2.

**Re claim 29:** Broka disclose:

an output device arrange to display information;

a memory;

a computer connected to store information;-see Fig. 2 and cols. 5-10.

Further, an apparatus would have been necessary to perform the method of previously rejected claim 1, therefore the claim 29 is rejected using the same art and rationale.

**Re claims 30-36, 39, 42-43, 45-56:**

Further an apparatus is disclosed by Broka in Fig. 2 and cols. 5-10 and would have been necessary to perform the method

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of previously rejected claims 2-8,11, 14-15, 17-28 and are therefore rejected using the same art and rationale.

5. Claims 9-10, 12, 13, 16, 37-38, 40-41, 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Broka in view of Lawrence (US Patent No. 5,915,209).

**Re claim 9: Broka disclose:**

An account identifier -see "Participant ID " FIG. 39, Broka does not specifically disclose a state associated with the desired securities, or an inquiry number. Lawrence, however teaches a bond trading system including solicitation of information on bids including a state of origin-see col. 10, lines 51-56 and an inquiry number "JobEntry #" -see Fig. 6. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Broka to include a state designation to allow an investor to purchase investments such as municipal bonds and a JobEntry number to facilitate the references to a transaction.

**Re claim 10: Broka disclose:**

Wherein single inquiry further comprise a quantity-see Figs. 18a-b, a price range-see col. 17 lines 4-44, and a range of maturity times -see -see col. 19 lines 25-28.

**Re claim 12: Broka disclose:**



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wherein each said entry further comprises the par dollar amount of the security associated with the entry, and the maturity time of the security associated with the entry-see col. 19 lines 25-29 ("Maturity year") and ("PAR Value, maturity date")-col. 22 lines 38-44, Fig. 50. Broka do not explicitly disclose that the purchase information contain a state designation. Lawrence however, teaches a bond trading system including solicitation of information on bids including a state of origin-see col. 10, lines 51-56. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Broka to include a state designation to allow an investor to purchase investments such as municipal bonds.

**Re claim 13:** Broka disclose:

entry further comprises a CUSIP for said security associated with said entry. -see Fig. 35 (3550) and col. 19 lines 29-34.

**Re claim 16:** Broka disclose:

said finalizing comprises entering a CUSIP and a broker or dealer identification-("Users enters their user identification (ID)...A user chooses Enter Trade Report function 1110 if the user is a participant in a bond trade

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transaction...The data captured and validated for a report includes participants...If the user is a dealer, FIPS supplies the Enter Trade Report window..."-see col. 11 lines 2-67. Broka does not refer to finalizing comprises entering a CUSIP. Lawrence however, teaches executing buy and sell transactions [finalize] -see col. 6 lines 28-35 and entering CUSIP numbers in Fig. 6, also, see Fig.7 ("BUY", "Sell" and CUSIP number listed in last column). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Broka to include when finalizing a transaction, data such as CUSIP numbers are entered in order to ensure that the correct bond is being traded and designated as such in the appropriate databases.

**Re claims 37-38, 40-41, 44:** Further an apparatus is disclosed by Broka in cols. 5-10 and Fig. 2 and would have been necessary to perform the method of previously rejected claims 9-10, 12-13, 16 and are therefore rejected using the same art and rationale.

### **Conclusion**

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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US Patent No. 5,913,202 (Motoyama)-cited for its reference to financial information delivery system based on user preferences.

US PG. Pub. 2002/0143694 (Young)-cited for its reference to optimizing a portfolio and trading bonds with different issuers in order to avoid wash sales.

US PG. Pub. 2002/0056004 (Smith)-cited for its reference to a method and system of processing financial data and listing of approved issuers of securities.

US PG. Pub. 2002/0052824 (Mahanti)- cited for its reference to a method and apparatus for electronic trading.

Dalton, John M. *How the Stock Market Works*. NYIF 1993. pp.83-85. cited for its reference to quotes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elda Milef whose telephone number is (571)272-8124. The examiner can normally be reached on Monday - Friday 9:15 am to 5:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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